

REMARKS

Reconsideration and the timely allowance of the pending claims, in view of the following remarks, are respectfully requested.

In the Final Office Action of March 14, 2006, the Examiner rejected claims 1-3 and 5, under 35 U.S.C. §103(a), as allegedly being unpatentable over Nobakht '223 (U.S. Patent No. 6,745,223) in view of Maissel '516 (U.S. Patent No. 6,637,029); rejected claims 11-13, 16-17, and 20, under 35 U.S.C. §103(a), as allegedly being unpatentable over Nobakht '223 and Maissel '516 in view of Allport '299 (U.S. Patent No. 6,882,299).

By this Amendment, Applicants have amended claims 1-3, 5, 11-13, 16-17, and 20 to provide a clearer presentation of the claimed subject matter and have cancelled claims 4, 6-10, 14-15, and 18-19, without prejudice or disclaimer. Applicants submit that no new matter has been introduced. As such, claims 1-3, 5, 11-13, 16-17, and 20 are currently presented for examination, of which claims 1, 5, 11-13, 16-17, and 20 are independent. Moreover, by virtue of the cancellations, the rejections of claims 4, 6-10, 14-15, and 18-19 have been rendered moot.

Applicants respectfully traverse the prior art rejections, under 35 U.S.C. §103(a) for the reasons presented below

I. Prior Art Rejections Under 35 U.S.C. §103(a).

Each of the independent claims positively recite that the program selecting data contained in the received digital broadcast data is recorded into the memory of the memory card that contains contract information for descrambling the digital broadcast data. These features are amply supported by the embodiments described in the Specification.

As a preliminary matter, Applicants remind the Examiner that, in order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. As a corollary to this requirement, the Federal Circuit has specifically held that the mere fact that *the prior art could be modified* as proposed by the Examiner *is not sufficient* to establish a *prima facie* case of obviousness. (See, *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (*emphasis added*). Rather, the Examiner *must explain why the prior art would have suggested* to one of ordinary skill in the art *the desirability of the modification*. (See *Fritch*, 972 F.2d at 1266, 23 USPQ2d at 1783-84) (*emphasis added*).

Second, there must be a reasonable expectation of success. And third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (See, MPEP 2142).

With this said, Applicants submit that, contrary to the Examiner's assertions, the applied references do not teach or suggest the combination of features recited in claim 1. In particular, the Nobakht '223 reference discloses that the channel table data downloaded to the set top box STP 131 is stored in SDRAM 218 within the STP 131. (See, Nobakht '223, col. 14, lines 1-10). Nobakht '223 also teaches the conventional use of a smart card for the authorization to services. (See, Nobakht '223, col. 6, line 63 - col. 7, line 32; FIG. 3(B)). As acknowledged by the Examiner, Nobakht '223 clearly fails to teach or suggest that the channel table data is capable of being recorded onto the memory card. Rather, the channel table data is *only* recorded in SDRAM 218.

The Examiner's reliance on Maissel '516 as allegedly meeting the limitation of recording the program selecting data into the memory of the memory card, is absolutely improper. First of all, Maissel '516 merely discloses that a "viewer preference profile" the view preference profile comprises the characterization of the programs currently

viewed by the viewer and have nothing to do with the program selecting data contained in the digital broadcast data, as required by the claims.

Equally notable is the fact that there is absolutely no suggestion or motivation to modify the features of Nobakht '223 to record program selecting data into the memory of the memory card. As noted above, the fact that the prior art could be modified as proposed by the Examiner *is not sufficient* to establish obviousness. Nobakht '223 specifically teaches that the channel table data is stored in SDRAM 218, without a hint as to alternative storage medium.

Furthermore, in contrast to the Examiner's assertions, Nobakht '223 neither discloses the desirability nor capability of loading or storing channel table data or viewer preference profiles onto other apparatuses. If anything, by virtue of disclosing that each user will have their own smartcard to be entered into the same apparatus (*see, Nobakht '223*, col. 7, lines 13-14), Nobakht '223 teaches multiple users using the same apparatus and effectively teaches away from a single user using multiple apparatuses. The motivation to record program selecting data contained in the digital broadcast data into the memory of the memory card only exists in the Applicant's written disclosure and to apply such motivation to these two references is clearly impermissible hindsight.

Applicants further submit that, as best understood, none of the remaining references, including Allport '299, cure the deficiencies identified above. Thus, for at least the reasons presented, Applicants submit that none of these references, whether taken alone or in reasonable combination, teach the claimed combination of elements recited by claim 1. Thus, claim 1 is patentable over the references. And, because claims 2-3 depend from claim 1, claims 2-3 are also patentable by virtue of dependency as well as for their additional recitations. Accordingly, Applicants request the immediate withdrawal of the prior art rejections of claims 1-3.

Moreover, because independent claim 5 recites features that are similar to the patentable features discussed above regarding claim 1, claim 5 is also patentable for the same reasons presented above. Accordingly, Applicants request the immediate withdrawal of the prior art rejections of claim 5.

Applicants further submit that claims 11-13, 16-17, and 20 recites features that are similar to the patentable features discussed above regarding claims 1 and 5, and are, therefore, equally patentable. However, claims 11-13, 16-17, and 20 also recite the use of a remote controller that remotely operates the control means and is equipped with operating members, a display unit, and a card slot and that, when the memory card is plugged into the card slot, the remote controller reproduces the program selecting data recorded on the memory, displays the program selecting data on the display unit, and sends program select information to the digital broadcast receiver selected based on the contents displayed on the display unit.

Applicants submit that there is nothing in the references of record that remotely teach such features. As such, claims 11-13, 16-17, and 20 are patentable for these additional reasons and Applicants request the immediate withdrawal of the prior art rejections of claims 11-13, 16-17, and 20.

II. Conclusion.

All matters having been addressed and in view of the foregoing, Applicants respectfully request the entry of this Amendment, the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

All matters having been addressed and in view of the foregoing, Applicant respectfully requests the Examiner's reconsideration of this application, and the immediate allowance of all pending claims.

Applicant submits that this Request for Reconsideration is proper under 37 C.F.R. §1.116 as it: (a) places the application in condition for allowance for the reasons discussed herein; (b) does not require any further consideration as there are no claim amendments and the claim features should have already been searched; and (c) places the application in better form for an Appeal, should an Appeal be necessary.

Applicant's Counsel remains ready to assist the Examiner in any way to facilitate and expedite the prosecution of this matter. If any point remains in issue in

which the Examiner feels may be best resolved through a personal or telephone interview, please contact the Undersigned at the telephone number listed below.

Please charge any fees associated with the submission of this paper to Deposit Account Number **033975**. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



E. RICO HERNANDEZ
Reg. No. 47641
Tel. No. (703) 770-7788
Fax No. (703) 770-7901

Date: June 9, 2006
ERH/smm
P.O. Box 10500
McLean, VA 22102
(703) 770-7900